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10/767,087	01/29/2004	Harald Michi	10191/3439	4599
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KENYON & KENYON LLP			MANCHO, RONNIE M	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/767,087

Applicant(s)

MICHIE ET AL.

Examiner

Ronnie Mancho

Art Unit

3663

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,6-9 and 11-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-9 and 11-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-3, 6-9, 11-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In amended claim 1, the applicant recites “the loss of **a speed regulating function occurs solely** via a command of the driver to the input device”. The disclosure does not limit the invention with the terminology, “solely”. In fact, nowhere in the disclosure is recited the limitation, “**a speed regulating function occurs solely** via a command of the driver”.

This is new matter.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-3, 6-9, 11-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Art Unit: 3663

In claim 1, applicant recites, “a loss of a speed regulating-function”. It is not clear what all is meant and encompassed by the limitation, “*a loss* of a speed-regulating function”. The disclosure is not clear as to what should be considered “a loss”.

The rest of the claims are rejected for depending on a rejected base claim.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-3, 6-9, 11-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In amended claim 1, the applicant recites, “the loss of a **speed regulating function occurs solely** via a command of the driver to the input device”. Then paragraph four of claim 1 also recites, “the decision unit .....automatically limits the desired speed”. Thus the limitations are in conflict. The rejection also applies to “activated *only* above a limiting speed”

The applicant further claims “a first predetermined vehicle speed range”, “a second predetermined vehicle speed range”. The claimed speed ranges are indefinite. There are no definite bounds that differentiate the speed ranges as claimed. In actuality, the applicant’s specification, page 2, lines 1-3 recite, “a certain limiting speed, such as above 30 km/h”. Then lines 31-33 recite, “an upper limiting speed, such as up to 40 km/h. It is clearly seen that the speed ranges overlap and there is no clear distinction between the ranges.

Thus the limitation “a second predetermined speed vehicle speed range that is lower than the first predetermined vehicle speed range” is not enabled since the ranges overlap and there is no clear distinction between the claimed speed ranges.

Art Unit: 3663

In addition, the limitation, “wherein an upper limit of the second speed range is at least equal to the limiting speed” is not enabled. That is as disclosed in applicant’s specification, the “upper limit of the second speed range” is 40 km/hr. Then the limiting speed is 30 km/h. Surely, 40 km/h is not equal to 30 km/h.

The resulting claim does not clearly set forth the metes and bounds of the patent protection desired.

The rest of the claims are rejected for depending on a rejected base claim.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 1-3, 6-9, 11-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Hirasago (6658344).

Art Unit: 3663

Regarding claim 1, Hirasago (abstract, cols. 2, 4-7; figs. 1-31) discloses a speed controller for a motor vehicle comprising:

an input device to receive input of a desired speed by a driver (see inputs as in figs. 1-31), the input device having a plurality of operating modes (figs. 6 A-C; fig. 31 ) differing in functional scope, which operating modes are configured to be activated in different speed ranges, each operating mode having a corresponding number of speed regulating functions, wherein a change in a current operating mode which results in the loss of a speed regulating function occurs solely via a command of the driver (cols. 2&3) to the input device; and

a decision unit to determine, using predefined criteria, whether a change in the desired speed input by the driver is to be interpreted as a command for changing the current operating mode (controller; cols. 2, 4-7);

wherein a first of the plurality of operating modes is an operating mode for a first predetermined vehicle speed range that is configured to be activated only above a limiting speed, and a second of the plurality of operating modes is for a second predetermined vehicle speed range that is lower than the first predetermined vehicle speed range, and wherein an upper limit of the second speed range is at least equal to the limiting speed, and wherein the second operating mode provides in certain instances an automatic braking of the vehicle to a standstill;

wherein the decision unit automatically causes a change from the first operating mode into the second operating mode when the speed of the vehicle decreases to below the limiting speed and then automatically limits the desired speed to a value permitted in the second operating mode;

wherein the decision unit deactivates the speed controller when, in the second operating mode, the speed of the vehicle increases, and the driver does not input a new desired speed, while the actual speed of the vehicle lies within a predefined speed range.

Regarding claim 2, Hirasago (abstract, cols. 2, 4-7; figs. 1-31) discloses the speed controller of claim 1, further comprising a display device adapted to display the current operating mode.

Regarding claim 3, Hirasago (abstract, cols. 2, 4-7; figs. 1-31) discloses the speed controller of claim 1, further comprising a signal device to signal to the driver a change in the current operating mode.

Regarding claim 6, Hirasago (abstract, cols. 2, 4-7; figs. 1-31) discloses the speed controller of claim 1, wherein the decision unit automatically causes a change from the first operating mode into the second operating mode when the desired speed is lower than the limiting speed  $V_s$  and when the actual speed of the vehicle is less than  $V_s + h_1$ , where  $h_1$  has a non-negative value.

Regarding claim 7, Hirasago (abstract, cols. 2, 4-7; figs. 1-31) discloses the speed controller of claim 1, wherein the decision unit automatically causes the change from the first operating mode into the second operating mode when one of the following occur:

- a) the desired speed is increased to a threshold value which is at least equal to the limiting speed; and
- b) the actual speed of the vehicle does not increase to the limiting speed within a predefined time interval.

Art Unit: 3663

Regarding claim 8, Hirasago (abstract, cols. 2, 4-7; figs. 1-31) discloses the speed controller of claim 1, wherein the decision unit automatically causes the change from the second operating mode into the first operating mode when the desired speed is increased by the driver to a value that is greater than  $V_s + h_1$ ,  $V_s$  being the limiting speed and  $h_1$  having a non-negative value.

Regarding claim 9, Hirasago (abstract, cols. 2, 4-7; figs. 1-31) discloses the speed controller of claim 1, wherein the decision unit deactivates the speed controller when, in the second operating mode, the desired speed is less than or equal to the limiting speed  $V_s$  and the actual speed is greater than a threshold value  $V_s + h_2$ , where  $h_2$  has a non-negative value.

Regarding claim 11, Hirasago (abstract, cols. 2, 4-7; figs. 1-31) discloses the speed controller of claim 1, wherein the decision unit activates the speed controller in the first operating mode when, upon the input of the desired speed, the actual speed of the vehicle is greater than the limiting speed and the decision unit activates the speed controller in the second operating mode and limits the desired speed when, upon the input of the desired speed, the actual speed of the vehicle is less than or equal to the limiting speed.

Regarding claim 12, Hirasago (abstract, cols. 2, 4-7; figs. 1-31) discloses the speed controller of claim 11, wherein the decision unit activates the speed controller in the second operating mode only when a target object is located by a distance sensor system and the distance from the vehicle to this target object lies within a predefined range.

Regarding claim 13, Hirasago (abstract, cols. 2, 4-7; figs. 1-31) discloses the speed controller of claim 12, wherein the decision unit automatically deactivates the speed controller in



Art Unit: 3663

the second operating mode when the target object is not detected lost and is not re-detected within a predefined time span.

Regarding claim 14, Hirasago (abstract, cols. 2, 4-7; figs. 1-31) discloses the speed controller of claim 12, wherein the decision unit automatically deactivates the speed controller in the second operating mode when the distance between the vehicle and the target object becomes greater than a predefined value.

**MPEP 2114.**

The statement of intended use or field of use, “automatically causes a change from the.....when the speed of the .....decreases to”, “automatically limits the desired speed”, etc clauses are essentially method limitation or statement of intended or desired use.

Thus, the claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2nd 1647. See MPEP § 2114 which states:

A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ 2nd 1647.

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. *In re Danly*, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528.

Art Unit: 3663

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

Applicant may overcome the rejections drawn to MPEP 2114 by changing “automatically causes a change from the.....when the speed of the .....decreases to” to for example the limitation --configured to automatically causes a change from the.....when the speed of the .....decreases to”.

### ***Response to Arguments***

9. Applicant's arguments filed 4/14/06 have been fully considered but they are not persuasive.

Applicant's arguments drawn to the amended claims are not convincing. The limitations are replete with 112 issues as pointed out above. The rejections drawn to phrases such as “being activatable” have been withdrawn in view of applicant's amendments using the phrase “configured to”.

Applicant's argument drawn to the limitation, “the loss of a **speed regulating function occurs solely** via a command of the driver to the input device” is not convincing. The disclosure does not limit the invention with the terminology, “solely”. In fact, nowhere in the disclosure is recited the limitation, “**a speed regulating function occurs solely** via a command of the driver”.

This is new matter.

In the limitation, “a loss of a speed regulating-function”, it is not clear what all is meant and encompassed by the limitation, “**a loss** of a speed-regulating function”. The disclosure is not clear as to what should be considered “a loss”. Applicant's contention that “a speed regulating

Art Unit: 3663

function that exists in the old operating mode (before the change) does not exist in the new operating mode” is not convincing because there is no loss in speed. The speed regulating function in one mode can always be retuned to after switching from one to another. This does not imply “a loss” as claimed.

Applicant’s argument with respect to speed ranges is not convincing because the speed ranges are not clearly defines, they actually overlap as pointed out in the 112 rejections above and as shown in fig. 2 of applicant’s drawing.

As already pointed out in the previous action, the applicant’s arguments are drawn entirely to method limitations. Assuming that the prior art did not disclose the method limitations, which the examiner is not conceding, the prior art anticipated the structural limitations of the claims and thus is capable of performing the method limitations. Applicant’s contention that the claim limitations have been ignored is not convincing. All claim limitations were evaluated and considered at least with 112, 102, and MPEP 2114 rejections. Applicant did not use the phrase “configured to” in all sections of the claims, thus MPEP 2114 still applies.

Applicant’s argument drawn to *In re Casey*, 512 USPQ 235 and *In re Otto* is not convincing. The cases are an addition to: *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *Ex parte Masham*, 2 USPQ 2nd 1647; *In re Dally*, 120 USPQ 528, 531. It is noted that it is incorrect for the applicant to ignore some of the cited case laws.

Applicant’s argument drawn to the prior art not disclosing multiple operating modes distinguished with regard to scope, number of speed-regulating functions, etc is not convincing.

Art Unit: 3663

The prior art discloses an input device to receive input of a desired speed by a driver (see inputs as in figs. 1-31), the input device having a plurality of operating modes (figs. 6 A-C; fig. 31 ) differing in functional scope, which operating modes are configured to be activated in different speed ranges, each operating mode having a corresponding number of speed regulating functions, wherein a change in a current operating mode which results in the loss of a speed regulating function occurs solely via a command of the driver (cols. 2&3) to the input device; and

a decision unit to determine, using predefined criteria, whether a change in the desired speed input by the driver is to be interpreted as a command for changing the current operating mode (controller; cols. 2, 4-7);

wherein a first of the plurality of operating modes is an operating mode for a first predetermined vehicle speed range that is configured to be activated only above a limiting speed, and a second of the plurality of operating modes is for a second predetermined vehicle speed range that is lower than the first predetermined vehicle speed range, and wherein an upper limit of the second speed range is at least equal to the limiting speed, and wherein the second operating mode provides in certain instances an automatic braking of the vehicle to a standstill;

wherein the decision unit automatically causes a change from the first operating mode into the second operating mode when the speed of the vehicle decreases to below the limiting speed and then automatically limits the desired speed to a value permitted in the second operating mode.

Art Unit: 3663

wherein the decision unit deactivates the speed controller when, in the second operating mode, the speed of the vehicle increases, and the driver does not input a new desired speed, while the actual speed of the vehicle lies within a predefined speed range.

The prior art is capable of performing the claimed functional limitations since the prior art anticipates the structure of the invention.

It is believed that the prior art anticipates the claims. The rejections thus stand.

### ***Communication***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronnie Mancho whose telephone number is 571-272-6984. The examiner can normally be reached on Mon-Thurs: 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on 571-272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Application/Control Number: 10/767,087

Page 13

Art Unit: 3663

Ronnie Mancho  
Examiner  
Art Unit 3663

6/7/07



JACK KEITH  
SUPERVISORY PATENT EXAMINER